



UNITED STATES DEPARTMENT OF COMMERCE
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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
59-13184	12-13-87	STANLEY A. HIGGS	59-13184

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EXAMINER	
HIGGS/V	
ART UNIT	PAPER NUMBER
155	191

DATE MAILED: 02/14/88

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined ☒ Responsive to communication filed on 12-13-87 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), — days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|--|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449 | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152 |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474 | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 59 to 70 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 59 to 62 and 64 to 69 are rejected.
5. ☒ Claims 63 and 70 are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.
8. ☐ Allowable subject matter having been indicated, formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. These drawings are ☐ acceptable; ☐ not acceptable (see explanation).
10. ☐ The ☐ proposed drawing correction and/or the ☐ proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner, ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved, ☐ disapproved (see explanation). However, the Patent and Trademark Office no longer makes drawing changes. It is now applicant's responsibility to ensure that the drawings are corrected. Corrections MUST be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474.
12. ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received
☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

16. Claims 59 to 62 and 64 to 69 are rejected under 35 U.S.C. 102(a) as being fully met by any one Japanese Patents Nos. 56-2336 and 55-160044 for the reasons stated in the Office action mailed September 28, 1983.

The 37 CFR 1.131 affidavit fails to overcome the rejection. The affidavit is submitted by one Michel Foure, but no confirmation is provided by applicants that he'd performed the work described therein on their behalf prior to the references effective dates. Furthermore the showings do not serve any probative purpose as they fail to establish earlier reduction to practice of an organotin mercapto

carboxylate halide in combination with a thiol ester.

Applicants rebuttal concerning the scope of the known prior art vis-a-vis support for the subject organotin halides in both the parent application S.N. 70,503 filed August 28, 1979 and the French priority application is misplaced as it is well known that a 37 CFR 1.131 declaration must show priority with respect to as much as the claimed invention as the reference happens to show. The stabilizer permutations shown in the affidavit do not even attempt to support reduction to practice of references' the organotin mercapto carboxylate halides.

According to In re Rainier et al 156 USPQ 334 (CCPA-1969) a showing to antedate a reference which is not a statutory bar need not include all specific embodiments of invention. However it must show that generic concept was previously established as by inference to common functionality for entire genus based on species reduced to practice. No such espousal by applicants is presented in the proffered affidavit. Furthermore mere theorization, contrary to applicants counsel's remarks is insufficient to support the class. In re Wiggins et al 179 USPQ 421. In any event, applicants expansion of the stabilizer compound's disclosure by filing the instant application is indica-

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tive that they themselves considered the earlier applications' disclosure unsupportive of the scope of the organotin compounds previously as well as presently claimed. Accordingly, establishment of an earlier generic concept encompassing the use of the references' organotin mercapto carboxylate halides in combination with the thiol ester has not been presented.

17. Claims 63 and 70 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Veronica P. Hoke
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GROUP 150 - ART UNIT 153

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